

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN THE MATTER OF THE APPLICATION FOR REISSUE OF:

APPLICANT: Outten et al. )  
U.S. PATENT NO.: 5,719,107 )  
ISSUED: February 17, 1998 )  
TITLED: CRANKCASE LUBRICANT FOR )  
HEAVY DUTY DIESEL OIL )

Atty. Docket No. 96L206

ASSIGNEE: Infineum USA L.P. )

**REISSUE DECLARATION UNDER 37 C.F.R. 1.175;**  
**OFFER TO SURRENDER PATENT; AND**  
**POWER OF ATTORNEY**

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

Infineum USA L.P., having a place of business at 1900 East Linden Avenue, Linden, NJ 07036, as assignee of the entire title, rights and interest in and to United States Patent No. 5,719,107, request reissue of the identified patent and declare as follows:

That the specification of the patent has been reviewed and it is verily believed that Edward Francis Outten and Andrew James Dalziel Ritchie are the original, first and joint inventors of the invention described and claimed in the attached specification for reissue of United States Patent No. 5,719,107, which patent issued February 17, 1998 from application Serial No. 695,353, filed August 9, 1996;

That the contents of the above-identified application, including the amended claims have been reviewed and are understood;

That it is not believed that the claimed invention was known or used in the United States before invention thereof by the named inventors;

That the invention described and claimed in the present patent specification has not been patented or made the subject of an inventor's certificate in any country foreign to the United States on an application filed by the inventors, their legal representatives or assigns more than twelve months prior to the August 9, 1996 filing of original application Serial No. 695,353;

That the only applications for Letters Patent or an inventor's certificate on the invention that have been filed by the inventors, their legal representatives or assigns in any country foreign to the United States are as follows:

<u>Application No.</u>	<u>Country</u>	<u>Day-Month-Year</u>
PCT/US97/13368	PCT	29-07-97
97937056.6	EP	29-07-97
3966497	AU	29-07-97
2259205	CA	29-07-97
50977098	JP	29-07-97
9806302-7	SG	29-07-97

wherein the EP application designated BE, DE, ES, FR, GB, IT and NL; and the applications in AU, CA, JP and SG represent national stage filings of the noted PCT application;

That the duty to disclose information that is material to the examination of this application in accordance with 37 CFR Section 1.56(a) is acknowledged;

That it is verily believed that said Letters Patent is, through error and without deceptive intention, wholly or partially inoperative by reason of applicants having claimed more than they had a right to claim in that the inventors failed to clearly exclude metal-containing compounds, such as alkaline earth metal salts of alkylphenol thioesters and calcium nonylphenol sulfide from the definition "sulfurized phenols" of element (E) of claim 1, and element (D) of claims 8, 9 and 10, which compounds should clearly have been excluded based on the fact that formulations containing less than 0.3 mass % (claims 1 and 9) or less than 1.96 mass % (claims 8 and 10) cannot simultaneously contain "at least 0.3 mass %" (claims 1 and 9) or "at least 2.4 mass %" (claims 8 and 10) of a metal phenate as required by element (B) of each of claims 1, 8, 9 and 10;

That the errors recited in the previous paragraphs render said patent partly inoperative and arose without any deceptive intention on the part of the inventors, their assigns or legal representatives;

That the reasons for the errors that arose without deceptive intent are that, when the application was drafted, the general definition of "sulfurized phenates" was taken from a prior application without consideration of the fact that certain sulfurized phenols could be considered metal phenates causing an overlap in the definition between the metal phenate, which is required in a specified amount, and the sulfurized phenols, substantial amounts of which were meant to be excluded; it being applicants intent to exclude substantial amounts of ashless (metal-free) sulfurized phenols, particularly the commonly used nonyl phenyl sulfide (NPS);

That applicants and assignee did not notice the apparent inconsistency during reviews prior to filing of the application, or during the prosecution thereof, said inconsistency being first brought to assignees attention by the European Patent Office during examination of the corresponding European Patent Application;

That as a result of a careful study of the present application in view of the comments of the European Patent Examiner it was recognized that the claims of the present patent were partially inoperative in that said claims did not clearly and unambiguously claim the invention described in the specification, and the claims of this reissue application are presented to remedy the aforementioned defect;

That acceptance of a patent with claims not commensurate with the true scope of the invention was not intended and the acceptance of such a patent was wholly inadvertent;

That claims 1, 8, 9 and 10, as amended, now remedy the deficiencies of the issued claims of the patent;

That the amendments to the claims does not seek to enlarge the scope of the original patent and, thus, this reissue oath may be made and sworn by the assignee of the entire interest in and to the application in accordance with 37 CFR Section 1.172, providing that the ownership interest of said assignee is established by filing in the reissue application a submission in accordance with the provisions of 37 CFR Section 3.73(b);

That to establish the ownership interest of said assignee in accordance with the provisions of 37 CFR Section 3.73(b), the assignee, Infineum USA L.P., notes the assignment from the inventors to Exxon Chemical Patents Inc., recorded with the U.S. Patent and Trademark Office at reel 8278/Frame 0134, and provide herewith a copy of a concurrently filed assignment assigning the entire right, title and interest in and to the precursor application from Exxon Chemical Patents Inc. to Infineum USA L.P.;

That Infineum USA L.P. hereby offers to surrender the original patent (U.S. Patent No. 5,719,107) upon which the above-identified application for reissue is based; and

That Infineum USA L.P. hereby revokes all prior powers of attorney and appoints John W. Ditsler (Reg. No. 27,124) and Jacob M. Levine (Reg. No. 32,509) to prosecute this application, and to transact all business in the U.S. Patent and Trademark Office connected therewith, and requests that all correspondence in connection with this application be addressed to:

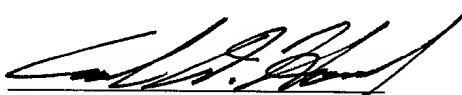
Jacob M. Levine  
Infineum USA L.P.  
Law Department  
1900 East Linden Avenue  
PO Box 710  
Linden, NJ 07036.

It is declared that all statements made herein of undersign's own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

Wherefore we pray that Letters Patent be granted for the invention described and claimed in the foregoing specification and claims.

Date: July 20, 2001

Assignee; Infineum USA L.P. by



Carl Howard  
Corporate Secretary